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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,034	07/30/2003	William D. Honnick	IR 3448A (1222.0100-01-00)	7768
34986	7590	12/19/2005	EXAMINER	
LAW OFFICES OF ROBERT J. EICHELBURG HODAFEL BUILDING, SUITE 200 196 ACTON ROAD ANNAPOLIS, MD 21403			LEADER, WILLIAM T	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,034

Applicant(s)

HONNICK, WILLIAM D.

Examiner

William T. Leader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 27-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40, 42, 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7-30-2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Applicant's election of Group II, claims 40, 42 and 43, in the reply filed on October 26, 2005, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 40 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,669,835. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are essentially the same except the patent recites an inorganic particulate carrier having a particle

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size less than 100 microns while instant claim 40 recites an inorganic particulate carrier having a particle size less than 20 microns. Choice of a value from within the disclosed range of the patent would have been obvious.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 42 and 43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harris et al (5,672,432).

7. The Harris et al patent was cited and applied during the prosecution of parent application 08/995,887. Harris et al disclose a conductive substrate coated with a cured polymer

composition. See, for example, column 2, lines 15-32. It is not apparent that the coated conductive substrate of claims 42 and 43 differs from that of Harris et al.

8. Claims 42 and 43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Doshi et al (4,341,689).

9. The Doshi et al patent was cited and applied during the prosecution of parent application 08/995,887. Doshi et al disclose a conductive substrate coated with a cured polymer composition. It is not apparent that the coated conductive substrate of claims 42 and 43 differs from that of Doshi et al.

10. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al (5,672,432) combined with Doshi et al (4,341,689) for the reasons given during the prosecution of the patent applicant and summarized below.

11. Harris teaches the formation of an aqueous dispersion of a polymer, wherein the dispersion has incorporated into it pigments (column 8, lines 35-42), and wherein the resin dispersion and the pigment dispersion include the self-cross-linking polymer of the Harris invention along with other resins or polymers or cross-linkers that may have been co-dispersed with the polymer of the invention. The polymer of the Harris invention is an electrocoating composition that may include water-miscible or water-soluble co-solvents (column 7, lines 29-32) along with water. Harris discloses at column 10, lines 44-58 that a greater percentage of the dispersion is water. This is taken to be an "aqueous matrix" as the term is used by applicant at

specification. Harris also discloses the use of inorganic particulate carriers (column 7, line 60).

Harris does not disclose the use of a water incompatible catalyst sorbed onto the inorganic particulate carrier.

12. Doshi disclose a two-component polyurethane coating system which includes the incorporation of an inorganic particulate carrier which has sorbed thereon an amine catalyst (column 1, lines 54-68; column 2, lines 42-46 and claims 1-15). The use of the amine catalyst on the molecular sieve causes displacement of the water into the molecular sieve to speed up the reaction rate (column 2, lines 40-50).

13. The prior art of record is indicative of the level of skill of one of ordinary skill in the art. It would have been obvious at the time the invention was made to have utilized a water incompatible catalyst to coat an inorganic particulate as disclosed by Doshi in an aqueous dispersion of a cathodic electrocoat composition of cross-linking polymers as disclose by Harris because Doshi discloses that the use of such catalysts speeds up the curing process while reducing hazing of the final surface finish (column 2, lines 46-50). The product recited by applicant is considered to be suggested Harris et al combined with Doshi et al.

14. Applicant is advised that should claim 42 be found allowable, claim 43 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245.

The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WL

William Leader
December 6, 2005

ROY KING 
SUPERVISORY PATENT EXAMINER
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